Decision for dispute CAC-UDRP-101159

Case number	CAC-UDRP-101159
Time of filing	2016-01-25 12:22:50
Domain names	roma2024.com, roma2024.org, rome2024.org

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	CONI - COMITATO OLIMPICO NAZIONALE ITALIANO

Complainant representative

Organization	De Simone & Partners S.p.A.

Respondent

Name	Gustavo Valbuena

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

The Complaint owns the Italian word trade mark ROMA 2024 (No. 0001661944), filed on 25 February 2015 and registered on 18 December 2015.

It also filed an application for the Italian word and design trade mark COMITATO ROMA 2024 (No. 302015000012047/UB2015C034746) on 16 April 2015.

FACTUAL BACKGROUND

The Complainant is the Italian national representative of the International Olympic Committee and is the public body in charge of regulating and managing all sports matters in Italy. The Roma 2024 Committee is part of the Complainant and has the task of promoting the candidature of the city of Rome to host the Olympic Games in 2024.

Nothing is known about the Respondent, apart from the fact that he is an individual resident in Spain.

The disputed domain names were registered on 22 January 2007.

When the Complainant first became aware of the disputed domain name <roma2024.com> in November 2015, it was pointing to a website displaying a number of blog posts dating from 2011 detailing the Respondent's self-titled collection of 38 "Olympic city domains". The website also contained sponsored links and links to websites selling Olympic memorabilia. Although the website contained a clear disclaimer that the Respondent was not stating any intention to sell these domain names, it also contained other wording such as "I have received mails asking me if I am willing to sale only one domain or the whole collection, my answer has always be that all domains are available individually or as a whole. Please submit your best offer by email all offers will be treated with strictest confidence" (4 October 2011) and "If you ara an OLYMPIC MEMORABILIA COLLECTORS and want to Own a unique piece of history, contact me" (sic) (7 January 2015).

On 4 December 2015, the Complainant sent a cease and desist letter to the Respondent. Further to this, on 6 December 2015, the Respondent updated the website to which <roma2024.com> was pointing by adding a post headed "FREE SPEECH ISSUE" and stating that he wanted to create a forum where the public could discuss Rome's Olympic bid. The sponsored links were also removed.

The other two disputed domain names, <roma2024.org> and <rome2024.org>, are currently not pointing anywhere and no evidence regarding any previous pointing has been supplied.

PARTIES CONTENTIONS

Parties' Contentions

Complainant

Identical or confusingly similar

The Complainant argues that the applicable top-level suffix (for example .COM) would usually be disregarded as it is a technical requirement of registration, and points out that as a result the disputed domain names <roma2024.com> and <roma2024.org> are identical to the Complainant's registered Italian word trade mark in the term ROMA 2024 (No. 0001661944). In addition, the Complainant argues that the disputed domain name <rome2024.org> is confusingly similar to this trade mark. The Complainant also contends that the fact that its trade mark rights post-date the date of registration of the disputed domain names is irrelevant for the purposes of paragraph 4(a)(i)of the Policy.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed domain names, nor that the Respondent is making a bona fide offering of goods and services. In the Complainant's opinion, the Respondent's use of <roma2024.com> is intended to mislead internet users for commercial gain as the Respondent is trying to "ride on the coat-tails" of the reputation of the ROMA 2024 candidature bid. Finally, the Complainant states that the Respondent has not been licensed or otherwise authorized to use any of the Complainant’s trade marks nor to apply for nor use any domain name incorporating such trade marks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant explains in detail that the pattern "city + year" is internationally synonymous with the Olympic Games and is a distinctive sign instantly capable of indicating to consumers the Olympic origins of the goods and services bearing that sign. As a result, it is also largely predictable that a city may acquire potential rights in the pattern "city + year" as any candidature progresses, and the year is predictable by counting every two (for winter Olympics) or every four (for summer Olympics) years from the previous Games. Thus for example, as far as the summer games are concerned, the word Rome could be associated with the year 2008 or 2012 or 2016 or 2020 or 2024 etc.

The Complainant points out that the disputed domain names were registered in January 2007 and, in that period, it was well known that Rome may be the candidate city for the Olympic Games of 2024. The Complainant provides a detailed explanation to support this contention and argues that, as someone who appears to be very well informed about the

Olympics, the Respondent could have believed in the possibility of the candidacy of Rome for the Olympic Games of 2024 and registered some possible variants of the related domain name in order to take advantage of the confusion between the said domain names and any potential future rights of the Complainant in the sign ROMA 2024.

Turning to bad faith use, the Complainant argues that the Respondent is using the disputed domain name <roma2024.com> to attract internet users to his website for commercial gain by creating a likelihood of confusion in accordance with paragraph 4(b)(iv) of the Policy. The Respondent highlights the previous existence of sponsored links on the corresponding website and underlines that such links are usually found to indicate bad faith (even if a third party such as the registrar is obtaining commercial gain and not the Respondent because such links have been placed there automatically).

Finally, the Complainant underlines that, even though the disputed domain names <roma2024.org> and <rome2024.org> are not being actively used by the Respondent, passive holding may amount to bad faith use in certain circumstances, and argues that this is the case here, especially given the reputation of the Complainant's trade mark.

Respondent

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has shown, to the satisfaction of the Panel, that the Respondent has no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has shown, to the satisfaction of the Panel, that the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In this case the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel is therefore obliged to make its decision on the basis of the factual statements contained in the Complaint and the documents made available by the Complainant to support its contentions.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following for a panel to order a transfer of the domain name(s) at issue:

(i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Taking each of these issues in turn, the Panel decides as follows:

A. Identical or Confusingly Similar

Based on the evidence put forward by the Complainant, the Panel finds that the Complainant has trade mark rights in the term ROMA 2024.

The Panel notes that two of the disputed domain names incorporate the Complainant's ROMA 2024 trade mark in its entirety (<roma2024.com> and <roma2024.org>). The third disputed domain name, <rome2024.org>, only differs from the Complainant's trade mark by one letter, and this does nothing to distinguish it from the Complainant's trade mark, especially as "Roma" and "Rome" both refer to the same city (the first in Italian, the second in English).

It is widely accepted that the generic Top Level Domain suffix .COM is generally irrelevant for the purpose of assessing identity or confusing similarity between a trade mark and a domain name. The Panel also agrees with the Complainant that registration of a domain name before a complainant acquires trade mark rights in a name does not prevent a finding of identity or confusing similarity under paragraph 4(a)(i) of the Policy (although this may be relevant when considering the question of bad faith).

On the basis of these considerations, the Panel finds that the disputed domain names are identical or confusingly similar to a trade mark in which the Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the disputed domain names (Policy, paragraph 4(a)(ii)).

Paragraph 4(c) of the Policy sets out various ways in which a respondent may demonstrate rights or legitimate interests in the domain name(s) at issue, as follows:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Panel has considered the evidence put forward by the Complainant and is of the view that the Complainant has presented a clear prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain names. As a result of its default, the Respondent has failed to rebut that showing.

First, with regard to <roma2024.com> which is being used to point to the Respondent's website, in the Panel's opinion the disclaimer on the website does not alter the fact that the relevant domain names listed are for sale, and indeed the website

still contains clear wording to this effect (examples of which are set out in the Factual Background above). In addition, the website previously contained sponsored links (as evidenced by the screen captures provided by the Complainant) and still contains links to stores selling Olympic memorabilia. In the Panel's opinion the Respondent is therefore profiting from the Complainant's reputation and the fact that internet users may be searching for its official website to increase traffic to his own website and thus increase the commercial revenues from his various activities on it (namely the sale of domain names, sponsored links and links to websites selling Olympic memorabilia). As a result, the Panel finds that the Respondent cannot be considered to be making a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy referred to above.

In the Panel's opinion it is significant that the Complainant sent its cease and desist letter to the Respondent on 4 December 2015 and then only two days later, on 6 December 2015, the Respondent added a blog post headed "FREE SPEECH ISSUE" and stated that he wanted to create a forum where the public could discuss Rome's Olympic bid. The sponsored links were also removed. Considering that the website had existed since 2011 and had never previously contained this type of content, in the Panel's opinion it is highly likely that, upon receipt of the Complainant's cease and desist letter, the Respondent realised that the commercial content of the website was potentially an issue and attempted to rectify this by creating a discussion forum and posting survey questions for the general public such as "Do you want Rome to host the Olympic games in the year 2024?". Although the Complainant received a delivery failure in response to its cease and desist letter to the Respondent's email address, when the CAC sent an email to the same address it did not, and the Panel is therefore of the opinion that the Respondent's actions are unlikely to be a co-incidence and were a deliberate attempt to create a defence of fair use.

However, the Panel finds that the Respondent's use of <roma2024.com> cannot be said to be a legitimate non-commercial or fair use within the meaning of paragraph 4(c)(iii) of the Policy for a number of reasons. First, if the change to a discussion forum and the removal of the sponsored links was indeed prompted by the Respondent's notice of the dispute, then as a matter of principle respondents cannot simply attempt to correct previous abusive behaviour when put on notice by the trade mark holder. This would not provide any certainty or fairness for complainants, who would be obliged to monitor future use of the domain name at issue and decide at what point its use crosses the line and becomes abusive.

Secondly, given that the disputed domain name exactly matches the Complainant's trade mark, in the Panel's opinion the average internet user will expect it to be used to point towards an official website run by the Complainant and may thus be confused upon accessing the Respondent's website and think that they are interacting with the Complainant. In this regard it is significant that the website does not contain any disclaimer clearly stating that the Respondent is not connected to the Complainant. In the light of this the Panel believes that it is not possible for the Respondent to claim fair use, especially in view of the continuing commercial activity on the website (sale of domain names, links to websites selling Olympic memorabilia).

Furthermore, no evidence has been supplied that the Respondent is commonly known by the disputed domain name, as referred to at paragraph 4(c)(ii) of the Policy.

Turning to <roma2024.org> and <rome2024.org>, there is no evidence that these domain names have ever been used and so no evidence of any legitimate interest of any kind by the Respondent.

Given the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The third element that the Complainant must prove is that the disputed domain names have been registered and are being used in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy sets out various circumstances which may be treated by the Panel as evidence of the registration and use of a domain name in bad faith, as follows:

"For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the

Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

First, with regard to bad faith registration, the Panel agrees with the Complainant's assertions and finds that the Respondent was certainly aware of the Complainant at the time that the disputed domain names were registered in 2007, and registered them in bad faith with the Complainant's future rights in mind.

With regard to <roma2024.com> and bad faith use, the Panel is satisfied that the Respondent's conduct falls within paragraph 4(b)(iv) of the Policy, as argued by the Complainant, for the reasons explained in Section B above, namely that the Respondent is deliberately exploiting the likelihood of confusion with the Complainant to increase traffic to his website and thus his commercial revenues. In addition, the Panel also believes that paragraph 4(b)(ii) of the Policy potentially applies given the fact that certain of the domain names offered for sale on the Respondent's website(s) most likely match registered or unregistered trade marks and internet users will expect them to point to official websites. The Respondent's actions in registering them will no doubt have prevented the corresponding trade mark owners from acquiring such domain names and may thus result in a sale to a trade mark owner (although the Panel does not find that this was the Respondent's primary purpose for their registration, as per paragraph 4(b)(i), merely an incidental possibility arising from it). In this regard the Panel notes that the Respondent also owns <doha2024.org>, although this is not listed on his website.

Turning to <roma2024.org> and <rome2024.org>, the Panel finds that in this case the Respondent's passive holding of these domain names is sufficient to demonstrate bad faith use (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003), in particular because of the reputation of the Complainant's trade mark and the fact that it is not possible to conceive of any plausible good faith use of such domain names by anyone other than the Complainant.

The Panel therefore finds that the disputed domain names have been registered and are being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ROMA2024.COM**: Transferred
2. **ROMA2024.ORG**: Transferred
3. **ROME2024.ORG**: Transferred

PANELLISTS

Name	**Jane Seager**

DATE OF PANEL DECISION 2016-03-15